UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/314,172	05/19/1999	HIROKI KANNO	016907/0967	4798

			EXAMINER
7590	08/19/2004		POKRZYWA, JOSEPH R

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ART UNIT	PAPER NUMBER
2622	

DATE MAILED: 08/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.		Applicant(s)
Office Action Summary	09/314,172		KANNO ET AL.
	Examiner		**Art Unit**
	Joseph R. Pokrzywa		2622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>03 March 2004</u>.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

·3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>19-34</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>19-34</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

Response to Amendment

1.   Applicant's amendment was received on 5/27/04, and has been entered and made of

record. Currently, **claims 19-34** are pending.

Response to Arguments

2.   Applicant's arguments filed 5/27/04 have been fully considered but they are not

persuasive.

In response to applicant's arguments regarding the rejection of **claim 19**, cited in the

Office action dated 5/27/04 as being anticipated by Li *et al.* (U.S. Patent Number 5,506,697),

whereby applicant argues on pages 5 and 6 that Li fails to teach of synthesizing first image data

(based on reading a document) with second image data, where the second image data is

indicative of at least one of operating conditions which determine image quality of the reading

means, an image processing means and an image forming means. As seen in column 8, lines 4

through 18, Li teaches that "symbol 45 can be encoded by encoder 44 to also include application

data ...[that] may identify particular software used to generate the original document text, such

as word processing software or spreadsheet software". Further, as read in column 2, lines 35

through 34, the encoded symbol is used to "produce a printed copy of the original document free

of any image degradation occurring during facsimile transmission." Thus, the symbol 45 is

indicative of operating conditions which determines the image quality of the image forming

means. Currently, claim 19 requires the second image data being indicative of **at least one of**

operating conditions which determine image quality of the reading means, the image processing

means and the image forming means. Therefore, Li can be interpreted as teaching of synthesizing

first image data with second image data, where the second image data is indicative of at least one

of operating conditions which determine image quality of the reading means, an image

processing means and an image forming means.

Continuing, applicant argues on pages 6 and 7 that Li fails to teach that both the first and

second image data are synthesized on the same sheet of paper. The examiner notes that the first

image data is interpreted as document text 40a within original document 40, as seen in Fig. 3,

and read in column 7, lines 46 through 56. Continuing, as read in column 7, line 66 through

column 8, line 3, "the printer 46 reprints the text 40a in conjunction with coded symbol 45 on a

clean document sheet. Document 50 thus represents either original document 40 bearing encoded

symbol 45 or a reprint of the original document bearing coded symbol 45." Therefore, the coded

symbol is synthesized with the original image to create a "reprint of the original document

bearing coded symbol 45". Because of this, Li can be interpreted as teaching that both the first

and second image data are synthesized on the same sheet of paper.

3.   Therefore, the rejection of *claim 19*, as cited in the Office action dated 3/3/04, under 35

U.S.C. 102(b), as being anticipated by Li *et al.*, is maintained and repeated in this Office action.

Claim Rejections - 35 USC § 102

4.   The text of those sections of Title 35, U.S. Code not included in this action can be found

in a prior Office action.

5.   **Claims 19-21, 25, 29, 33, and 34** are rejected under 35 U.S.C. 102(b) as being

anticipated by Li *et al.* (U.S. Patent Number 5,506,697, cited in the Office action dated 3/3/04).

Regarding *claim 19*, Li discloses an image forming apparatus (see Figs. 3, 7 and 8,

column 7, lines 53 through 56, and column 11, line 41 through column 12, line 2) comprising

reading means for reading a document and providing image data on the document as first image

data (scanner 42, column 7, lines 48 through 54), image processing means for processing the first

image data provided by the reading means (column 7, lines 48 through 61, and column 11, line

41 through column 12, line 34), image forming means for forming an image on a sheet of paper

corresponding to input image data (printer 46, column 7, line 56 through column 8, line 3, and

column 12, lines 28 through 34), operating condition image producing means for producing

image data as second image data (code symbol 45, being produced by the encoder 44, column 7,

lines 46 through 56), indicative of at least one of operating conditions which determine image

quality of the reading means, the image processing means and the image forming means (column

8, lines 4 through 26, column 9, lines 12 through 42, and column 11, lines 20 through 40),

synthesizing means for synthesizing the first image data processed by the image processing

means with the second image data produced by the operating condition image producing means

(see Fig. 3, coded symbol 45, printed on document 50, column 7, line 56 through column 8, line

3), means for controlling the image forming means to form an image corresponding to the first

and second image data synthesized by the synthesizing means on the sheet of paper (see Fig. 3,

coded symbol 45, printed on document 50, column 7, line 56 through column 8, line 3, and

column 12, lines 11 through 20), means for designating whether or not the first image data

obtained by the image processing means should be synthesized with the second image data

produced by the operating condition image producing means (being the designation of encoded

symbol mode, seen as step 172 in Fig. 8, column 12, lines 3 through 28), and the synthesizing

means synthesizes the first image data obtained by the image processing means with the second

image data produced by the operating condition image producing means and provides resultant

synthesized image data in a case where the designating means designates synthesis (step 180,

when designated to be in the symbol mode, as "yes" in step 172, column 12, lines 11 through

20), and provides only the first image data obtained by the image processing means in other

cases (step 174, column 12, lines 6 through 10).

Regarding *claims 20 and 21*, Li discloses the apparatus discussed in claim 19, and further

teaches that the operating condition image producing means includes means for producing a

character image data and a pattern code image data indicative of the operating conditions

(column 7, line 56 through column 8, line 34).

Regarding *claim 25*, Li discloses the apparatus discussed in claim 19, and further teaches

that the operating condition image producing means includes means for producing an image data

indicative of processing conditions of the image processing means (column 4, line 62 through

column 5, line 12, and column 8, lines 4 through 34).

Regarding *claim 29*, Li discloses the apparatus discussed in claim 20, and further teaches

that the operating condition image producing means includes means for producing an image data

indicative of processing conditions of the image processing means (column 4, line 62 through column 5, line 12, and column 8, lines 4 through 34).

Regarding *claim 33*, Li discloses the apparatus discussed in claim 21, and further teaches that the operating condition image producing means includes means for producing an image data indicative of processing conditions of the image processing means (column 4, line 62 through column 5, line 12, and column 8, lines 4 through 34).

Regarding *claim 34*, Li discloses the apparatus discussed in claim 21, and further teaches that the image corresponding to the second image data is user readable (column 6, lines 41 through 59).

Claim Rejections - 35 USC § 103

6.   The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

7.   **Claims 22-24, 26-28, and 30-32** are rejected under 35 U.S.C. 103(a) as being unpatentable over Li *et al.* (U.S. Patent Number 5,506,697, cited in the Office action dated 3/3/04) in view of Antognini *et al.* (U.S. Patent Number 6,176,427, cited in the Office action dated 3/3/04).

Regarding *claims 22, 26, and 30*, Li discloses the apparatus discussed in claims 19, 20, and 21, respectively, but fails to expressly disclose if the operating condition image processing means includes means for producing an image data indicative of input conditions of the reading means.

Antognini discloses an image forming apparatus (see Fig. 24) comprising reading means

for reading a document and providing image data on the document as first image data (being

inherent in a facsimile machine, column 22, line 47 through column 23, line 7, column 47, lines

28 through 45, and column 48, lines 1 through 28), image processing means for processing the

first image data provided by the reading means (steps 2401 and 2402, column 47, lines 28

through 38), image forming means for forming an image on a sheet of paper corresponding to

input image data (printed onto a substrate at step 2404, whereby a printer is inherently in a

facsimile machine), operating condition image producing means for producing image data as

second image data (digitally encoded substrate, see Figs. 1 and 2), indicative of at least one of

operating conditions which determine image quality of the reading means, the image processing

means and the image forming means (see Fig. 2, column 19, lines 3 through 26, column 20, lines

15 through 57, and column 24, line 59 through column 25, line 14), synthesizing means for

synthesizing the first image data processed by the image processing means with the second

image data produced by the operating condition image producing means (see Fig. 9, column 22,

line 47 through column 23, line 7, and step 2404, column 47, lines 28 through 62), means for

controlling the image forming means to form an image corresponding to the first and second

image data synthesized by the synthesizing means on the sheet of paper (step 2404 in Fig. 24,

column 47, lines 28 through 62). Further, Antognini teaches that the operating condition image

producing means includes means for producing an image data indicative of input conditions of

the reading means (column 19, lines 3 through 26).

Li & Antognini are combinable because they are from the same field of endeavor, being

systems that encode data on substates.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to further include a means for producing an image data indicative of input conditions of the reading means, as taught by Antognini, in the system of Li.

The suggestion/motivation for doing so would have been that Li's system would become more efficient, as Li's system would include the ability to determine the optimum printer/scanner combination for the desired output, as recognized by Antognini in column 1, lines 41 through 58, and column 4, lines 49 through 62.

Therefore, it would have been obvious to combine Antognini's teachings with the system of Li to obtain the invention as specified in claims 22, 26, and 30.

Regarding *claims 23, 27, and 31*, Li discloses the apparatus discussed in claims 19, 20, 21, respectively, but fails to particularly teach if the operating condition image processing means includes means for producing an image data indicative of a resolution and sampling rate of the reading means.

Antognini discloses an image forming apparatus (see Fig. 24) comprising reading means for reading a document and providing image data on the document as first image data (being inherent in a facsimile machine, column 22, line 47 through column 23, line 7, column 47, lines 28 through 45, and column 48, lines 1 through 28), image processing means for processing the first image data provided by the reading means (steps 2401 and 2402, column 47, lines 28 through 38), image forming means for forming an image on a sheet of paper corresponding to input image data (printed onto a substrate at step 2404, whereby a printer is inherently in a facsimile machine), operating condition image producing means for producing image data as second image data (digitally encoded substrate, see Figs. 1 and 2), indicative of at least one of

operating conditions which determine image quality of the reading means, the image processing means and the image forming means (see Fig. 2, column 19, lines 3 through 26, column 20, lines 15 through 57, and column 24, line 59 through column 25, line 14), synthesizing means for synthesizing the first image data processed by the image processing means with the second image data produced by the operating condition image producing means (see Fig. 9, column 22, line 47 through column 23, line 7, and step 2404, column 47, lines 28 through 62), means for controlling the image forming means to form an image corresponding to the first and second image data synthesized by the synthesizing means on the sheet of paper (step 2404 in Fig. 24, column 47, lines 28 through 62). Further, Antognini teaches that the operating condition image processing means includes means for producing an image data indicative of a resolution (column 19, lines 3 through 26, column 20, lines 15 through 57, and column 24, line 59 through column 25, line 14) and sampling rate of the reading means (column 15, line 18 through column 16, line 16).

Li & Antognini are combinable because they are from the same field of endeavor, being systems that encode data on substates.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to further include a means for producing an image data indicative of a resolution and sampling rate of the reading means, as taught by Antognini, in the system of Li.

The suggestion/motivation for doing so would have been that Li's system would become more efficient, as Li's system would include the ability to determine the optimum printer/scanner combination for the desired output, as recognized by Antognini in column 1, lines 41 through 58, and column 4, lines 49 through 62.

Therefore, it would have been obvious to combine Antognini's teachings with the system

of Li to obtain the invention as specified in claims 23, 27, and 31.

Regarding *claims 24, 28, and 32*, Li discloses the apparatus discussed in claims 19, 20,

and 21, respectively, but fails to specifically teach if the operating condition image processing

means includes means for producing an image data indicative of output conditions of the image

forming means.

Antognini discloses an image forming apparatus (see Fig. 24) comprising reading means

for reading a document and providing image data on the document as first image data (being

inherent in a facsimile machine, column 22, line 47 through column 23, line 7, column 47, lines

28 through 45, and column 48, lines 1 through 28), image processing means for processing the

first image data provided by the reading means (steps 2401 and 2402, column 47, lines 28

through 38), image forming means for forming an image on a sheet of paper corresponding to

input image data (printed onto a substrate at step 2404, whereby a printer is inherently in a

facsimile machine), operating condition image producing means for producing image data as

second image data (digitally encoded substrate, see Figs. 1 and 2), indicative of at least one of

operating conditions which determine image quality of the reading means, the image processing

means and the image forming means (see Fig. 2, column 19, lines 3 through 26, column 20, lines

15 through 57, and column 24, line 59 through column 25, line 14), synthesizing means for

synthesizing the first image data processed by the image processing means with the second

image data produced by the operating condition image producing means (see Fig. 9, column 22,

line 47 through column 23, line 7, and step 2404, column 47, lines 28 through 62), means for

controlling the image forming means to form an image corresponding to the first and second

image data synthesized by the synthesizing means on the sheet of paper (step 2404 in Fig. 24, column 47, lines 28 through 62). Further, Antognini teaches that the operating condition image producing means includes means for producing an image data indicative of output conditions of the image forming means (column 10, lines 34 through 46, and column 19, lines 3 through 26).

Li & Antognini are combinable because they are from the same field of endeavor, being systems that encode data on substates.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to further include operating condition image producing means includes means for producing an image data indicative of output conditions of the image forming means, as taught by Antognini, in the system of Li.

The suggestion/motivation for doing so would have been that Li's system would become more efficient, as Li's system would include the ability to determine the optimum printer/scanner combination for the desired output, as recognized by Antognini in column 1, lines 41 through 58, and column 4, lines 49 through 62.

Therefore, it would have been obvious to combine Antognini's teachings with the system of Li to obtain the invention as specified in claims 24, 28, and 32.

Conclusion

8.   **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO
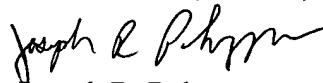
MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the mailing

date of this final action.

9.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Joe Pokrzywa whose telephone number is (703) 305-0146. The

examiner can normally be reached on Monday-Friday, 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Edward L. Coles can be reached on (703) 305-4712. The fax phone number for the

organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Joseph R. Pokrzywa
Examiner
Art Unit 2622

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